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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,060	07/09/2001	Roger Collins	05545.P001	9276

7590

03/21/2003

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EXAMINER

WAMSLEY, PATRICK G

ART UNIT

PAPER NUMBER

2819

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/902,060

Applicant(s)

Collins et al

Examiner

Patrick Wamsley

Art Unit

2819



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Applicant is advised that the "Notice of Allowance" dated 12/17/2002 is vacated. If the issue fee has already been paid applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new "Notice of Allowance", applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a deposit account. Prosecution on the merits of this application is reopened on claims 1-30 considered unpatentable for the reasons indicated below:

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15 and 20-30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent 5,771,010 to Masenas, hereafter Masenas, cited as an "X" reference for these claims on an International Search Report mailed on 11/25/2002.

For claim 1, Masenas provides a method comprising the steps of identifying a data block within an electronic message; generating a pointer identifying the block [by means of a history buffer] from a previous electronic message; and replacing the data block with the pointer. Claim 11 restates these method elements in apparatus format.

For claim 21, Masenas also provides a method comprising the steps of providing an interface and replacing data blocks with pointers.

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For claims 2, 12, and 23, Masenas transmits data to a device for storage.

For claims 3, 13, and 24, Masenas decompresses a message by inserting data from a previous message [corresponding to a substitution code].

For claims 4, 14, and 25, Masenas identifies a previous message based on a subject field

For claims 5, 15, and 26, Masenas identifies if a message is in response to a previous message.

For claims 6 and 27, Masenas uses various compression techniques

For claims 7 and 28, Masenas replaces common strings of characters with codes.

For claims 8 and 29, Masenas defines one character string as an e-mail address domain.

For claims 9 and 30, Masenas uses six bits of code per character

For claims 10 and 22, Masenas compresses e-mail messages.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masenas in view of EP 909,037 to Ishida et al, hereafter Ishida, cited as a "Y" for these claims on an International Search Report mailed on 11/25/2002.

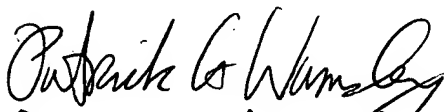
Unlike claim 16, Masenas does not clearly recite alternate compression modules. In contrast, Ishida discloses selection of multiple compression methods, such as run-length and Lempel Ziv [abstract, last three lines], thereby applying alternate compression modules. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have applied Ishida's teachings to the system of Masenas. The motivation would have been to apply optimum compressing methods to different data blocks, as suggested by Ishida on lines 3-6 of page 3.

For claim 17, Masenas defines one character string as an e-mail address domain.

For claim 18, Masenas uses six bits of code per character

For claim 19, Masenas compresses e-mail messages.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick G. Wamsley whose telephone number is (703) 305-3504.


Patrick G. Wamsley
March 6, 2003